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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/741,564

12/18/2000

John M. Hibscher

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04/27/2004

NEAL, GERBER, & EISENBERG  
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CHICAGO, IL 60602

EXAMINER

ENATSKY, AARON L

ART UNIT

PAPER NUMBER

3713

DATE MAILED: 04/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/741,564

Applicant(s)

HIBSCHER ET AL.

Examiner

Aaron L Enatsky

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 13-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Response to Amendment***

Examiner acknowledges receipt of amendment on 01/05/04. Claims 14-32 are pending.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14-15, 17-18, 20-22, 24, 26, 29-30, 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,102,796 to Pajitnov et al. (Hereafter, Paj) in view of US Patent No. 5,599,231 to Hibino et al. (Hereafter, Hibino) in view of US 6,117,061 to Popat et al (Hereafter, Popat). Paj teaches on-line gaming played over networks such as the Internet and the World Wide Web (2:9-13). The primary gaming method and system is directed to a puzzle game (2:34-49). The game is played by downloading configuration, control modules, and game data from a remote server (4:25-29) to a gaming terminal. The game has further interaction with the server by uploading game data and processed by the server and in turn the server will provide a score to be downloaded by the computer gaming terminal (4:64-67). Downloaded control modules include code, applets, routine, programs, components, objects to implement the network game (8:41-44). These control modules serve to define HTML and application service script

Art Unit: 3713

modules. As the remote computer has software/game data to download, the remote computer has game storage. Paj teaches the online game played over the Internet, but does not teach linking a user identifier to game access or the ability to create, edit, or play games. Hibino teaches a user's ability to create, edit, and play multiple games tied to levels of authorized user access (4:4-16); and that the game system can be configured in an on-line network configuration (4:38-40).

Hibino further teaches that game information can be sent to a remote storage sever to provide further network access to other people, using this network embodiment in place of local floppy disk based storage solution (13:24-37). Lastly Hibino teaches that access to remote games is controlled by use identification (21:15-38). One would be motivated to modify Paj to include game editing and creation taught by Hibino so that one could create a game that would meet the necessary requirements of being quickly and easily solvable. Paj states that creating a balanced difficulty puzzle game is the key to keeping users interested in the game (2:1-18), therefore obvious to one of ordinary skill to give a user the ability to create and edit puzzle game, which allows a user to customize the level of difficulty involved to solve the puzzle. Paj in view of Hibino teaches a system that utilizes network connectivity, but do not provide game software as executable on a server. Popat is generally related to software for creating custom puzzles and other implements (Abstract and 2:52-60). Popat covers that the system operation may be in a local user mode, wherein a user designs and executes the software on a local machine (1:53-67). Popat also details that the software execution location is not dependent on local machine and can be executed remotely though a computer network over the Internet (6:35-45). The motivation to use such a remote system is evident in thin-client software design and dumb terminal as is known in the art. Such system designs remove the burden of managing hardware and software updates

by keeping such management resigned to a central location. Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Paj in view of Hibino to use the remotely accessed software to keep management costs to a minimum.

Claims 16, 23, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paj in view of Hibino in view of Popat as applied to claims 14-15, 17-18, 20-22, 24, 26, 29-30, 32 above, and further in view of US Patent No. 6,386,543 to Luker. Paj in view of Hibino in view of Popat discloses the claimed limitations as discussed above, but does not provide the on-line puzzle game to be a crossword puzzle. Luker teaches the ability to create, edit, solve, and store crossword puzzles over the Internet or applying such techniques using various other media storage known in the art (3:57-4:4). One would be motivated to modify Paj in view of Hibino in view of Popat to use the crossword puzzle taught by Luker as word games are a very prominent form of entertainment with a numerous game player base. Furthermore, the system taught by Paj is not limiting in the type of game that can be applied in an on-line context. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include crossword puzzles as a game choice because wide spread game acceptance ensures game popularity.

Claims 19, 25, 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paj in view of Hibino in view of Popat as applied to claims 14-15, 17-18, 20-22, 24, 26, 29-30, 32 above, and further in view of Applicant's admissions of prior art (Hereafter, App). Paj in view of Hibino in view of Popat discloses the claimed limitations as discussed above, but does not

Art Unit: 3713

provide detail of well-known applications and uses of web-based technology. App teaches various application and uses of web-based technology that are disclosed as old and well known in the art. App teaches that initially puzzles were provided by static HTTP methods (2:16-20). Then as the technology improved, various programming languages and modules were added such as JAVA and ShockWave to provide dynamic delivery of puzzles to users over the Internet/Web (3:11-4:21). Shockwave and JAVA can be embedded modules in both the server and client side web browser applications, which can then provide dynamic content and movies. By no means do these languages and modules provide the only means to dynamic interactivity on the Internet/Web, but merely a small number of a multitude of available technologies disclosed by App. One would be motivated to combine features of Paj in view of Hibino in view of Popat and App as both teach Internet available puzzle games that can constructed and played by users and modifying Paj in view of Hibino in view of Popat to include teachings of App would serve to further define what technologies could be used for the Paj in view of Hibino in view of Popat system. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Paj in view of Hibino in view of Popat to include the various implementation technologies taught by App to increase puzzle application usability, where employing the various implementation technologies would serve to increase operating system (OS) platform diversity as some technologies are only available on certain OS platforms. The use of the Shockwave as a module serves to define the use of a movie/multimedia module.

Art Unit: 3713

***Response to Arguments***

Applicant's arguments have been fully considered, but are not deemed persuasive. Applicant has modified the claims to include the feature of executing software on a remote system. Examiner has provided new reasons for rejection as described above.


***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron L Enatsky whose telephone number is 703-305-3525. The examiner can normally be reached on 8-6 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg can be reached on 703-308-1327. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ALE

  
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